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unpatentable over Bartholomew in view of McAllister, Silverman, or Baker. Applicants demonstrated in their Response of July 10, 2003, that Bartholomew did not anticipate claims 1-30 and 35-39 and none of the combinations of Bartholomew, McAllister, Silverman, or Baker can establish a prima facie case of obviousness. In response, the new Office Action of September 30, 2003, articulates new grounds for rejection each of which is addressed in the remarks below.

### REMARKS

Claims 1-6, 9-17 and 20-30 continue to stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 9-17, and 20-30 of copending Application No. 10015267. As applicants demonstrated in their earlier Response filed July 10, 2003, the rejection should be withdrawn for two reasons. First, the Office Action does not establish the necessary background for determining obviousness required by an obviousness-type double patenting rejection. Without establishing such a background, the obviousness-type double patenting rejection is improper. Second, the Office Action does not articulate reasons why a person of ordinary skill in the art would conclude that claims 1-6, 9-17, and 20-30 in the instant case are obvious in view of claims 1-6, 9-17, and 20-30 of copending Application No. 10015267. To support an obviousness-type double patenting rejection, the Examiner must articulate reasons why a why a person of ordinary skill in the art would conclude that claims 1-6, 9-17, and 20-30 in the instant case are obvious in view of claims 1-6, 9-17, and 20-30 of copending Application No. 10015267. No such reasoning has been presented. As such, the rejection is improper and should be withdrawn. The rejection is traversed in more detail below.

Claims 1, 2-4, 7-15, 18-26, 29, 30 and 35-39 now stand rejected under 35 U.S.C § 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119) or rejected under 35 U.S.C § 103 as being unpatentable over Bartholomew in view of McAllister, Timonen, Silverman, or Baker. Bartholomew, alone or in combination with McAllister, Timonen,

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Silverman, or Baker, does not disclose "identifying a particular callee" comprising "identifying, *at said destination device*, a callee identity associated with said utterance." Furthermore, Bartholomew, alone or in combination with McAllister, Timonen, Silverman, or Baker, does not disclose "identifying a particular callee" comprising "identifying a callee identity associated with said biometric input *at said destination device*." Claims 1-30 and 35-39 are therefore patententable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-30 and 35-39.

### ***Obviousness-type Double Patenting***

Claims 1-6, 9-17 and 20-30 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 9-17, and 20-30 of copending Application No. 10015267. Applicant maintains that rejection is improper for two reasons. First, the Office Action does not establish the necessary background for determining obviousness required by an obviousness-type double patenting rejection. Second, the Office Action does not articulate reasons why a person of ordinary skill in the art would conclude that claims 1-6, 9-17, and 20-30 in the instant case are obvious in view of claims 1-6, 9-17, and 20-30 of copending Application No. 10015267.

The Office Action does not establish the necessary background for determining obviousness. "A double patenting rejection of the obviousness-type is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103 . . . Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination.'"<sup>1</sup> *Graham v. John Deere Co.*, sets forth the factual inquiries required by the Examiner in establishing the

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<sup>1</sup> MPEP § 804.

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necessary background for determining obviousness.<sup>2</sup> The *Graham* factors require the Examiner to:

- (A) Determine the scope and content of the claims in Application No. 10015267 and the prior art relative to a claim in the instant application;
- (B) Determine the differences between the scope and content of the claims in Application No. 10015267 and the prior art and the claim in the instant application and the prior art;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.<sup>3</sup>

Neither the Office Action of April 11, 2003, nor the Office Action of September 30, 2003, even mention the *Graham* factors and both Office Actions fail to apply a single *Graham* factor to establish any of the necessary background elements for determining obviousness. The Office Action therefore cannot support an obviousness-type double patenting rejection and the rejection must be withdrawn.

The second reason that the rejection of claims 1-6, 9-17, and 20-30 must be withdrawn is that the Examiner has not presented any reasons why a person of ordinary skill in the art would conclude that claims 1-6, 9-17, and 20-30 in the instant case are obvious in view of claims 1-6, 9-17, and 20-30 of copending Application No. 10015267. "Any obviousness-type double patenting rejection should make clear . . . reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation . . . ."<sup>4</sup> Neither the Office Action of April 11, 2003, nor the Office Action of September 30, 2003, present any reason why claims 1-6, 9-17 and 20-30 of the instant case are not patentably distinct from claims 1-6, 9-17, and 20-30 of copending Application No. 10015267. Instead of the required analysis, the Office Action recites without further explanation the literal text of the independent claims 1, 12, and 23 of the instant case and independent claims 1, 12, and 23 of copending Application No. 10015267. The recitation of Applicant's own claims without any further explanation is

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<sup>2</sup> *Id.*

<sup>3</sup> *Id.*

<sup>4</sup> MPEP § 804.

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insufficient to support an obviousness-type double patenting rejection. The provisional rejection should be withdrawn.

Neither the Office Action of April 11, 2003, nor the Office Action of September 30, 2003, establish the necessary background for determining obviousness required by obviousness-type double patenting rejection. Furthermore, both Office Actions fail to articulate reasons why a person of ordinary skill in the art would conclude that claims 1-6, 9-17, and 20-30 in the instant case are obvious in view of claims 1-6, 9-17, and 20-30 of copending Application No. 10015267. The rejection of claims 1-6, 9-17, and 20-30 should therefore be withdrawn.

***Claim Rejections – 35 U.S.C. §102***

Claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39 stand rejected under 35 U.S.C. 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”<sup>5</sup> Applicants maintain the position that Bartholomew does not teach each and every element of claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39. As such, the rejection should be withdrawn and the claims should be allowed.

The present application is entitled “Destination Device Based Callee Identification” and each independent claim in the case recites “a destination device.” Independent claim 1 recites “[a] method for identifying a particular callee, said method comprising . . . identifying, *at said destination device*, a callee identity associated with said utterance. . . .” Independent claim 12 similarly recites “[a] system for identifying a particular callee, said system comprising . . . means for identifying a callee identity associated with said voice utterance *at said destination device*.” Independent claim 23 recites “[a] computer

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<sup>5</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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program product for identifying a particular callee, said computer program product comprising . . . means, recorded on said recording medium, for identifying a callee identity associate with said voice utterance at said *destination device*." Independent claim 35 recites a "method for identifying a callee, said method comprising" . . . "identifying a callee identity associated with said biometric input *at said destination device*." Independent claim 37 recites a "system for identifying a callee, said system comprising" . . . "means for identifying a callee identity associated with said biometric input *at said destination device*." Independent claim 39 recites a "computer program product for identifying a callee, said computer program product comprising" . . . "means, recorded on said recording medium, for identifying a callee identity associated with said biometric input *at said destination device*." Rejected claims 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, 36 and 38 depend from independent claims 1, 12, 23, 35, and 39 and include all of the limitations of those independent claims.

In rejecting claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39, the office action states that the 'IP 23' of Bartholomew "reads on the claim 'destination device'." The IP of Bartholomew is not a destination device as recited in claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39. The IP of Bartholomew is an acronym for "intelligent peripheral." Bartholomew specifically incorporates the definition of the IP from another patent to Wheeler, Jr.<sup>6</sup> who describes the IP as "a *separate network component* that . . . is distinct from the telephone company switching offices, trunk networks and any associated interoffice signaling network."<sup>7</sup> Because the IP of Bartholomew is not a "destination device," the rejection of claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39 should be withdrawn.

<sup>6</sup> U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. U.S. [sic] Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.")

<sup>7</sup> U.S. Patent No. 5, 572, 583, abstract, emphasis added.

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***Claim Rejections – 35 U.S.C. § 103***

Claims 3, 7, 9, 14, 18, 10, 25, and 29 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of U.S. Patent No. 6,101,242 to McAllister, U.S. Patent Application No., 2002/0058494 to Timonen, U.S. Patent No. 5, 875, 240 to Silverman, or U.S. Patent No. 5, 533, 109 to Baker. Applicants respectfully traverse each rejection. Not one of the proposed combinations can establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met.<sup>8</sup> First, the combination must teach or suggest all of Applicants' claim limitations.<sup>9</sup> Second, there must be a suggestion or motivation to combine the references.<sup>10</sup> Finally, there must be a reasonable expectation of success in the combination.<sup>11</sup>

***Bartholomew and McAllister***

Claims 3, 14, and 25 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of McAllister. The combination of Bartholomew and McAllister cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of 3, 14, and 25, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The combination of Bartholomew and McAllister does not teach or suggest all of Applicants' claim limitations. Rejected claims 3, 14 and 25 depend from claims 1, 12, and 23 respectively and include the limitations "identifying, *at said destination device*, a callee identity associated with said utterance," "means for identifying a callee identity associated with said voice utterance *at said destination device*," or "means, recorded on said recording medium, for identifying a callee identity associate with said voice utterance *at said destination device*." Neither Bartholomew nor McAllister teach these

<sup>8</sup> Manual of Patent Examining Procedure §2142.

<sup>9</sup> *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

<sup>10</sup> *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

<sup>11</sup> *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

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limitations. In fact, both Bartholomew and McAllister incorporate the same definition of an IP from another patent to Wheeler, Jr.<sup>12</sup> Because the combination of Bartholomew and McAllister does not teach each and every limitation of claims 3, 14, and 25, the combination of Bartholomew and McAllister cannot establish a prima facie case of obviousness.

There is also no suggestion or motivation to combine Bartholomew and McAllister. There is no suggestion or motivation to combine Bartholomew and McAllister because both references lack the same teaching. That is, both references do not teach, for example, "identifying, *at said destination device*, a callee identity associated with said utterance." There is no suggestion or motivation to combine the references, because the resultant combination still does not teach the limitations of claims 3, 14, and 25.

There is no reasonable expectation of success in the proposed combination. Because both Bartholomew and McAllister fail to teach "identifying, *at said destination device*, a callee identity associated with said utterance" the combination cannot work to identify, "*at said destination device*, a callee identity associated with said utterance." That is, Bartholomew and McAllister together cannot teach what is not disclosed in either reference alone. The combination therefore fails to establish a prima facie case of obviousness.

#### ***Bartholomew and Timonen***

Claims 5, 6, 16, 17, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bartholomew in view of Timonen. The combination of Bartholomew and Timonen cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of 5, 6, 16, 17, 27, and 28, there is no suggestion

<sup>12</sup> U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference."); U.S. Patent No. 6,101,242, column 12, lines 48-57 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.").

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or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The combination of Bartholomew and Timonen does not teach or suggest all of Applicants' claim limitations. Rejected claims 5, 6, 16, 17, 27, and 28 include the limitations "identifying, *at said destination device*, a callee identity associated with said utterance," "means for identifying a callee identity associated with said voice utterance *at said destination device*," or "means, recorded on said recording medium, for identifying a callee identity associate with said voice utterance at said *destination device*." Neither Bartholomew nor Timonen disclose these limitations. As discussed above, Bartholomew teaches an IP which is not a destination device. Timonen does not teach what Bartholomew lacks. Instead, Timonen discloses an encrypted message containing a digital signature sent to a third party<sup>13</sup> An encrypted message containing a digital signature is not identifying, at said destination device, a callee identity associated with said utterance. In fact, a destination device is not even mentioned in the cited sections of Timonen. Because the combination of Bartholomew and Timonen does not teach each and every limitation of claims 5, 6, 16, 17, 27, and 28 the combination of Bartholomew and Timonen cannot establish a prima facie case of obviousness.

There is also no suggestion or motivation to combine Bartholomew and Timonen. There is no suggestion or motivation to combine Bartholomew and Timonen because both references lack the same teaching. That is, both references do not teach, for example, "identifying, *at said destination device*, a callee identity associated with said utterance." There is no suggestion or motivation to combine the references, because the resultant combination still does not teach the limitations of 5, 6, 16, 17, 27, and 28.

There is no reasonable expectation of success in the proposed combination. Because both Bartholomew and Timonen fail to teach "identifying, *at said destination device*, a callee identity associated with said utterance" the combination cannot work to identify, "*at said destination device*, a callee identity associated with said utterance." That is,

<sup>13</sup> Timonen, paragraphs 0055 and 0056.



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Bartholomew and Timonen together cannot teach what is not disclosed in either reference alone. The combination therefore fails to establish a prima facie case of obviousness.

***Bartholomew and Silverman***

Claims 7, 18, and 29 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of Silverman. The combination of Bartholomew and Silverman also cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 7, 18, 29, 43, and 48, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The combination of Bartholomew and Silverman does not teach each and every element of claims 7, 18, 29, 43, and 48. Claims 7, 18, and 29 recite an "*origin device* . . . enabled to output said callee identity to a caller." The office action states "Silverman teaches displaying the called party identification information at the end-user device to which the call is routed before the call is answered."<sup>14</sup> The "end-user device to which the call is routed before the call is answered"<sup>15</sup> cannot be an "origin device," because it is the device *to which the call is routed*. The proposed combination of Bartholomew and Silverman therefore fails to teach each and every limitation of claims 7, 18, 29, 43, and 48, and cannot establish a prima facie case of obviousness.

There is no suggestion or motivation to combine Bartholomew and Silverman, because both Bartholomew and Silverman lack the same teaching. Both Bartholomew and Silverman do not teach an "*origin device* . . . enabled to output said callee identity to a caller." There is no suggestion or motivation therefore to combine Bartholomew and Silverman, because the resultant combination still does not teach the limitations of claims 7, 18, 29, 43, and 48.

<sup>14</sup> Office Action Dated April 11, 2003, paragraph 13.

<sup>15</sup> U.S. Patent No. 5, 875,240; column 2, lines 51-55.

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There is no reasonable expectation of success in the combination of Bartholomew and Silverman. The proposed combination teaches that "the routed call includes the called party identification information, which may be displayed on the end-user device *to which the call is routed* before the call is answered." The combination will not work to teach an "origin device . . . enabled to output said callee identity to a caller" as recited in claims 7, 18, and 29 because the combination teaches displaying "on the end-user device *to which the call is routed*."

***Bartholomew and Baker***

Turning now to claims 9 and 20, claims 9 and 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Bartholomew in view of Baker. The combination of Bartholomew and Baker also cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 9 and 20, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The proposed combination of Bartholomew and Baker does not teach each and every element of claims 9, and 20. Claim 9 depends from independent claim 1 and also includes the limitation "identifying, *at said destination device*, a callee identity." Claim 20 depends from claim 12 and includes the limitation "means for identifying a callee identity associated with said voice utterance *at said destination device*." Neither Bartholomew nor Baker teach identifying, *at said destination device*, a callee identity. Because the proposed combination of Bartholomew and Baker fails to teach every element of claims 9 and 20, the combination cannot establish a prima facie case of obviousness.

There is no suggestion or motivation to combine Bartholomew and Baker because both references lack the same teaching. Neither Bartholomew or Baker teach "identifying, *at said destination device*, a callee identity." There is no suggestion or motivation to combine Bartholomew and Baker because the resultant combination still fails to teach

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each element of claims 9 and 20. Bartholomew and Baker therefore cannot establish a prima facie case of obviousness.

There is also no reasonable expectation of success in the combination. Because neither Bartholomew nor Baker teach "identifying, *at said destination device*, a callee identity" the combination cannot work to identify, "*at said destination device*, a callee identity." That is, Bartholomew and Baker together cannot teach what is not disclosed in either reference alone. The combination of Bartholomew and Baker cannot establish a prima facie case of obviousness.

### *Conclusion*

Bartholomew, alone or in combination with McAllister, Silverman, or Baker, does not teach each and every element of claims 1-30 and 35-39. Bartholomew therefore does not anticipate claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, and 35-39. The proposed combinations of Bartholomew and McAllister, Timonen, Silverman, or Baker also fail to establish a prima facie case of obviousness because the proposed combinations do not teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. Applicants respectfully request the allowance of claims 1-30 and 35-39.

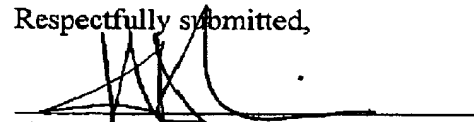
The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

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By:

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